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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,316	12/02/2003	Graham C. Charters	GB920020047US1/2798P	3102
29141	7590	02/22/2007	EXAMINER	
SAWYER LAW GROUP LLP P O BOX 51418 PALO ALTO, CA 94303			LEWIS, CHERYL RENEA	
		ART UNIT		PAPER NUMBER
				2167
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	02/22/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/726,316	CHARTERS, GRAHAM C.
	Examiner Cheryl Lewis	Art Unit 2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 01 December 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 43-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 43-72 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Response to Amendment***

1. This office action is in response to the applicant's communication received on December 1, 2006.
2. Claims 43-72 are presented for examination. Applicant has cancelled claims 1-42 and has introduced new claims 43-72 in the amendment received on December 1, 2006.
3. The drawing objection to figure 5 presented in the office action dated June 26, 2006 is hereby withdrawn.
4. Applicant's arguments with respect to claims 1-42 have been considered but are moot in view of the new grounds of rejection.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 43, 53, and 63 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

Claims 43, 53, and 63 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject. Claims 43, 53, and 63 are directed to defining and mapping a data definition from a first data element to a data element in a second data structure. The method, computer program product, and system of

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independent claims 43, 53, and 63 for mapping data definition of a data element to a data element of another data structure is at best a process and/or a series of steps implemented in software. Also, according to the specification on page 5 at line 11, the summary of the invention states that this invention is implemented by software.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

**Claim Rejections - 35 USC § 102**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 43-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomm et al. (Patent Number: 6,757,739 B1 filed June 5, 2000, hereinafter Tomm).

9. Regarding Claims 43, 53, and 63, Tomm teaches a method and apparatus for automatically converting the format of an electronic message.

The method and associated system for automatically converting the format of an electronic message as taught or suggested by Tomm includes:

selecting (col. 1, lines 62-67, col. 2, lines 1-4) a first data element (col. 3, lines 54-65) in the first data structure for mapping (col. 3, lines 54-67, col. 4, lines 1-67); a first possible data mapping definition to a user based (col. 5, lines 11-20, '...a user desires to produce two maps, one between message format-types A and B...') based on a first previous data mapping definition data mapping definition [Tom teaches a previous data mapping ('...a mapping engine 350 to create a translation map, as shown in FIG. 3. The translation map is used by translation engine 330 to convert, or translate a message...', col. 4, lines 13-17) definition between two data structures (i.e. 'SOURCE MESSAGE' element 310 and 'TARGET MESSAGE' element 320],

one from the first set (source message contains a plurality of fields, i.e. name, address, etc.) and one from the second set (target message contains a plurality of fields, i.e. name, location, etc.), the first possible data mapping definition (col. 4, lines 13-17, 'The translation map is used by a translation engine 330 to convert, or translate a message from a source format to a target format.') defining a mapping from the first data element (figure 3, i.e., 'NAME', fields 315, col. 4, lines 19-33) in the first data structure (figure 3, 'SOURCE MESSAGE', element 310, col. 4, lines 19-33) to a first data element (figure 3, i.e., 'NAME', fields 325, col. 4, lines 19-33) in the second data structure (figure 3, 'TARGET MESSAGE', element 320, col. 4, lines 19-33); mapping the first data element in the first data structure to the first data element in the second data structure according to the first possible data mapping definition (col. 4, lines 3-59) in response to acceptance of the first possible data mapping definition by the user (col. 5, lines 11-20), wherein the first previous data mapping definition defines a mapping from a data element in a third data structure to a data element in a fourth data structure (col. 4, lines 34-48), at least one of the third and fourth data structures being different from the first and second data structures (col. 4, lines 34-48).

10. Regarding Claims 44, 54, and 64, Tomm teaches a data structure is a message (figure 3, element 310) and a data element in the data structure is a field (figure 3, fields 315) in the message.

11. Regarding Claims 45, 55, and 65, Tomm teaches the first previous data mapping definition comprises a message name to message name definition (figure 3, element

315 NAME and element 317 data for the fields and element 325 NAME and element 327 data for the fields).

12. Regarding Claims 46, 47, 56, 57, 66, and 67, the limitations of these claims have been noted in the rejections of claims 43, 53, and 63 presented above. They are therefore rejected as set forth above.

13. Regarding Claims 48, 58, and 68, the limitations of these claims have been noted in the rejection of claims 43, 53, and 63 presented above. In addition, Tomm teaches a data mapping definition defined by the user in response to rejection of the first possible data mapping definition by the user in response to rejection of the first possible data mapping definition by the user (col. 4, lines 19-33) and storing data mapping definition defined by the user for future use (figure 2, element 207).

14. Regarding Claims 49, 59, and 69, the limitations of these claims have been noted in the rejection of claims 43, 53, and 63 presented above. In addition, Tomm teaches prioritizing possible data mapping definition (figure 3, element 310 comprises a series of fields 315 and 317 that are prioritized based on an element type, i.e. Name, Address, City, etc.) and data mapping based on a predefined rule (col. 4, lines 34 and 35).

15. Regarding Claims 50, 51, 60, 61, 70, and 71, the limitations of these claims have been noted in the rejections of claims 43, 49, 53, 59, 63, and 69 presented above. They are therefore rejected as set forth above.

16. Regarding Claims 52, 62, and 72, the limitations of these claims have been noted in the rejection of claims 43, 53, and 63 presented above. In addition, Tomm teaches a

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data mapping definition is based on a reverse (col. 5, lines 7-10) of the first previous data mapping definition.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**NAME OF CONTACT**

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone

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number for the organization where this application or proceeding is assigned is (571) 273-8300.

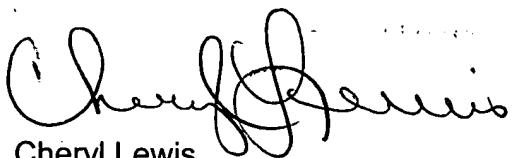
(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Lewis  
Patent Examiner  
February 16, 2007